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PRE-APPEAL BRIEF REQUEST FOR REVIEW

	Docket Number (Optional)
	AFL-15

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]	Application Number 10/779,537	Filed
on _____ Signature_____	First Named Inventor TRAN	
Typed or printed name _____	Art Unit 2167	Examiner Pham

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
    Note: No more than five (5) pages may be provided.

I am the

☑ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
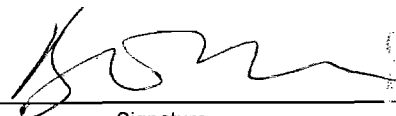(Form PTO/SB/96)

☑ attorney or agent of record. 37955
Registration number _____

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

_____
Signature

BAO TRAN
Typed or printed name

408 528 7490
Telephone number

1/15/07
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

In re application of:

    TRAN

Application No.: 10/779,537

Filed: 2/14/2004

Examiner: PHAM, MICHAEL

Art Unit: 2811

PRE-APPEAL BRIEF

      Applicants submits the Pre-Appeal Brief in response to the Final Office Action mailed 10-19-2006.

THE SECTION 102 REJECTION

      Claims 1, 4-7, 11-12, and 16-17 were rejected as anticipated by Grune, which describes a web-enabled tool that allows simultaneous intelligent searching, knowledge management based problem solving, valuation, and modeling of intellectual property and scientific information. Page 4 of the Office Action noted that, as to claim 1, Grune shows:

      A computer-implemented method for mapping intellectual property[Grune, 0010, search and map patents.], comprising:

      Searching (searching) one or more remote databases (databases) for one or more relevant patents [Grune, 0027, allows a user to enter a query via a'client computer that is connected to a server on a global area network. Intelligent searching also provides a user access to the stored intellectual property and scientific information contained on various databases.]; and

      performing a network analysis (map) on the relevant patents [Grune, [0048] that the program can be used to map patent citations or patent claims in hyperbolic tree formats] and

      displaying one or more patents (intellectual property)[Grune, [0048] The program allows for simultaneous modeling of the valuation and intellectual property results. The results may be displayed in various graphical formats.].

      Applicant respectfully traverses the rejection. A Section 102 rejection requires each and every element to be present. Here, at least the network analysis aspect is missing.

      As stated at the bottom of page 16 through top of page 17 of the instant application, one embodiment of network analysis can be as follows:

      Network analysis can generate sociograms (network diagrams) to visualize the networks being analyzed. One technique to draft a sociogram is to construct it around the circumference of a circle. The circle helps organize the data, but the order in which the points is determined only by an attempt to keep the number of lines connecting the various points to a minimum. Typically, a trial-and-error drafting process is used until an aesthetically pleasing result is achieved. While

such a process can make the structure of relations clearer, the relations between the sociogram's points reflect no specific mathematical properties. The points are arranged arbitrarily and the distances between them are meaningless. A number of techniques (e.g., metric and non-metric multidimensional scaling, correspondence analysis, spring-embedded algorithms, etc.) that mathematically represent the points in space can be used.

Other embodiments of network analysis are discussed on pages 20-24 of the instant application. Further, as defined by the on-line encyclopedia Wikipedia at http://en.wikipedia.org/wiki/Network_analysis:

> Network analysis is the analysis of networks through network theory (or more generally graph theory)...Social network analysis maps relationships between individuals in social networks...Link analysis is a subset of network analysis, exploring associations between objects. An example may be examining the addresses of suspects and victims, the telephone numbers they have dialed and financial transactions that they have partaken in in a given timeframe, and the familial relationships between these subjects as a part of police investigation. Link analysis here provides the crucial relationships and associations between very many objects of different types that are not apparent from isolated pieces of information...

In one embodiment of the instant invention, item 9 in the pseudo-code on page 18 of the instant application teaches that "[f]or each patent, create spring relationship among patents based on number of citation of patent prior art. Generate spring mass diagram. Allow user to play with the spring mass. For each patent, he can view each section of the patent, see PDF or TIFF versions."

Grune's paragraph 48 relates to the display of a particular graphical format known as hyperbolic tree. Specifically, Grune discloses that

> The results may be displayed in various graphical formats. Hyperbolic trees allow for the display of information on a hyperbolic plane using a focus plus context technique. The center of the tree is called a root, and the branches of information related to the root are displayed in the hyperbolic plane. The focus is easily shifted to a different part of the hyperbolic tree using a pointer device, such as a mouse, to choose a different root center.

Grune's paragraph thus relates to the display of the result. This correlates to the display operation recited in claim 1 and, as discussed on page 18 of the instant application, Figs. 8-9 show exemplary mappings of IPs that are analogous to Grune' paragraph 0048. As mentioned therein, in the exemplary display of Fig. 8, each patent is represented as a sphere. In Fig. 9, the patents are arranged as hyperbolic trees.

Hence, although Grune's paragraph 0048 discusses displaying patent citations or a patent's claims in hyperbolic tree format, Grune fails to show the claimed network analysis, which involves the application of network theory or graph theory.

Grune discloses that a single patent or claim can be placed at the center of the hyperbolic tree and related claims or patents are the branches connected to the root

center. However, the display of the hyperbolic tree does not correspond to the claimed performing a network analysis on the relevant patents and displaying them.

The Final Office Action at page 16 noted that "the applicant has essentially stated that network analysis is not novel by providing a public web definition, embodiments of network analysis being utilized, and further suggesting that the term network analysis is well-known." Applicant disagrees with equating dictionary definition with obviousness. Dictionary definition is commonly used to interpret the meaning of a claim and it is used to interpret the claim language in the response.

The Office Action notes that "it appears that the term network analysis is similar to the term mapping." However, as explained above, Grune' paragraph 48 relates to the display of graphical format, similar to the claimed display operation. However, Grune's hyperbolic tree display is not equivalent to the claimed network analysis of claim 1.

As Grune fails to disclose each and every element of the claim, Grune cannot anticipicate claims 1 and 16 and claims that depend therefrom such as claims 4-7, 11-12 and 17. Withdrawal of the Section 102 rejection is requested.

Further, Grune fails to disclose the additional citations of the dependent claims. For example, Grune's paragraph 11 fails to anticipate claim 4 since Grune's breaking sentences into noun-verb-adjective trees and then applying such tools as synonym indexes is not the same as clusterizing patents according to word similarity. Grune'paragraph 60 fails to anticipate claim 5 since Grune's split screen/full screen format is not the same as plotting on a large format plotter. As to claim 6, Grune's paragraph 10's audio/visual means in no way discloses or teaches the specifics of three-dimensionally visualizing the patents on a 3D display device. As to claim 11, Grune's Fig. 5 shows an Internet connected computer, but fails to show that the search work being distributed over a plurality of client computer (peer-to-peer (P2P) distribution of search load over a number of client computers). As to claim 12, Grune fails to show the P2P distribution of search load, further where the client computer is behind a firewall. As to claim 16, Grune fails to anticipate this claim since it does not show the means for performing network analysis in paragraph 48 as discussed above. As to claim 17, Grune's paragraph 48 fails to show the means for generating a computer readable intellectual property mapping file, as discussed above. Further Grune's paragraph 14 fails to disclose the generating means such as computer code for generating a collection of patent documents, each having one or more links embedded in the first portion referencing one or more external documents viewable using a viewer application; and one or more links embedded in the third portion referencing information contained in the second portion; and links generated by a network analysis of relationships among the patent documents as further shown on claim 18.

Since Grune fails to disclose elements recited in the dependent claims as well as the dependent claims, Grune cannot anticipate any of the claims. Withdrawal of the rejection is respectfully requested.

THE SECTION 103 REJECTION

Claims 2, 14-15 and 18-20 were rejected under Section 103 as unpatentable over Grune in view of Yeh. Yeh shows a system for displaying patent analysis information includes a patent information table, a citation analyzing module, an XML (extensible

markup language) converting module, an image converting module, and a user processing module.

With respect to claim 2, Grune does not show network analysis. Grune and Yeh do not show the network analysis and fails to show the specifics recited in claim 2 of receiving as a query one or more keywords or assignees to be searched; searching the query in Issued Patent or Published Application databases;retrieving cited prior art patents for each patent found in search results; updating the query by adding assignees from the cited prior art patents; and running a second search using the updated query. The rejection fails to address each element of claim 2, and thus fails to show that claim 2 is unpatentable over Grune and Yeh.

As to independent claim 14, Grune and Yeh fail to disclose the specific combination of: (a) receiving as a query one or more keywords or assignees to be searched; (b) searching the query in Issued Patent or Published Application databases; (c) retrieving cited prior art for each patent found as search results; (d) updating the query by adding assignees from the cited prior art; (e) iteratively repeating (b)-(d) using the updated query.

The Office Action acknowledged that "Grune does not explicitly disclose (c) retrieving cited prior art for each patent found as search results and relied on Yeh at 0038 which shows that a citation analysis module is used to generate citation information of a designated patent according to patent summary information stored in the patent information table." However, Yeh shows only citation information and does not show that cited patents are retrieved. Thus, the Office Action takes liberty with what Yeh shows and impermissibly uses hindsight from the present invention to arrive at its conclusion. Further, the Office Action asserts baldly that Grune in combination with Yeh discloses:

> (d) updating the query by adding assignees from the cited prior art;
> (e) iteratively repeating (b)-(d) using the updated query; and
> (f) displaying the intellectual property.

> Grune discloses that after information related to query is retrieved, data is sent to SIPS-VSM's utilities [0011]. Which further filters the results of the query such as grouping a result according to subject, publication date, assignee (adding assignee), etc. Grune further discloses, 0015, refined query (updated query), running a search again (repeating using updated query). Grune further discloses [0048] The program allows for simultaneous modeling of the valuation and intellectual property (intellectual property) results. The results may be displayed (display) in various graphical formats.

Applicant has carefully reviewed Grune and Yeh and fails to see how paragraphs 11, 14 and 48 show that the computer automatically performs updating the query by adding assignees from the cited prior art and iteratively repeating (b)-(d) using the updated query. Such iterative searches are used to improve the accuracy of the search result.

As a number of elements in the combination are completely missing in Grune and Yeh, they cannot render the claims obvious.

As to claim 15, as discussed earlier, Grune does not show the network analyzing the search results. As to claim 18, the examiner improperly used hindsight to reconstruct

the invention. This is the case since the claim relates to a patent document (in one instance a PDF document) with three portions. In one embodiment, the PDF patent document contains a prior art citation in the first section with links to the prior art, a description portion and a claim portion, where the claims contain links to references to the claim language in the description portion. The Office Action misconstrued claim 18, and then goes on a fanciful reconstruction on that incorrect construction of the claim. Yeh clearly does not disclose the element recited in claim 18. As to claim 19, as discusssed above for claim 14, Grune and Yeh fail to show the elements recited in claim 14 and 19. As to claim 20, Grune's Fig. 5 merely shows conventional client and server architecture and does not show claim 20's distributed processing such as the peer-to-peer distributed processing, for example. In sum, many of the specifics cited in the dependent claims are not shown. Hence, withdrawal of the Section 103 rejection is requested.

Claim 3 was rejected under 35 U.S.C. 103(a) as being unpatentable over Grune and further in view of Munzer. Again, as discussed above, neither Grune nor Munzer shows the network analysis element in the independent claims. Further, Munzer fails to show creating spring relationship among patents based on number of citation of patent prior art; and generating a spring mass diagram. There is no suggestion of the specifics of using citation as the basis for creating the spring relationship. Such suggestion came from the teachings of the present invention, and the Office Action has improperly applied hindsight in combining Grune and Munzer to arrive at claim 3. Withdrawal of the Section 103 rejection on claim3 is requested.

The Office Action rejected claims 8-10 and 13 over Grune and Rivette. The Office Action asserted that Rivette disclosses a caching sub-system that caches/retrieves cached patent data and asserts that such caching is the same as the claimed caching results from prior IP maps in a remote computer. Rivette shows an enterprise server with a local cache rather than remote client computers that performs caching of the IP data in a peer-to-peer context.

First, claims 8-10 and 13 are patentable over Grune and Rivette as they depend from allowable claim 1. As to claim 8, Grune and Rivette fail to show caching at a remote client computer. As to claim 9, Grune and Rivette fail to show retrieving a cached IP map from the remote client computer in response to a user request. Further, as to claim 10, Grune and Rivette fails to mention cache flushing at all. As to claim 13, Grune and Rivette fail to show the combination of annotating a patent at a local computer and caching the annotated patent at a remote computer to satisfy a subsequent request for the patent. Withdrawal of the Section 103 rejection is requested.

CONCLUSION

In view of the above, Applicant respectfully submits that all claims are in condition for allowance.

If for any reasons the Examiner believes a telephone conference would in any way expedite resolution of the issues raised in this appeal, the Examiner is invited to telephone the undersigned at 408-528-7490.

Respectfully submitted,

By: _____

Bao Tran